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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,436	02/22/2002	Wolfgang Daum	MRI-127	8223

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EXAMINER

SHEEHAN, JOHN P

ART UNIT PAPER NUMBER

1742

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/080,436	DAUM, WOLFGANG	
	<b>Examiner</b>	<b>Art Unit</b>	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-14, 16-18, 20-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-14, 16-18, 20-24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Substitute Specification***

1. The substitute specification filed June 4, 2004 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the statement as to a lack of new matter under 37 CFR 1.125(b) is missing.
2. It is noted that the proposed substitute specification submitted June 4, 2004 was accompanied by a declaration by Axel Winkel attesting to translation errors in the translation from "the original specification in German". This declaration is not persuasive because;
  - I. The declaration is unsigned and therefore carries no weight.
  - II. The declaration, although referring to the "the original specification in German", does not specifically describe "the original specification in German" as the German language specification that was originally filed in the USPTO on February 22, 2002 as the original specification in the instant application. Without such a description it is not clear what is meant by the term, "the original specification in German". Does this phrase, "the original specification in German", mean the German language specification that was originally filed in the USPTO on February 22, 2002 as the original specification in the instant application?

Applicants are advised that in order to have the new substitute specification entered they should:

- I. Submit a signed version of Winkel declaration. If the phrase, "the original specification in German" (used in the unsigned declaration submitted June 4, 2004) does mean the German language specification that was originally filed in the USPTO on February 22, 2002 as the original specification in the instant application then the declaration should clearly state this fact. Such a declaration, would, in view of MPEP 2163.07 (II), provide basis for the proposed changes:

>Where a U.S.application as originally filed was in a non-English language and an English translation thereof was subsequently submitted pursuant to 37 CFR 1.52(d),if there is an error in the English translation,applicant may rely on the disclosure of the originally filed non-English language U.S.application to support correction of an error in the English translation document.<

If the phrase, "the original specification in German" (used in the unsigned declaration submitted June 4, 2004) means anything other than the German language specification that was originally filed in the USPTO on February 22, 2002 as the original specification then, "the original specification in German" (as used in the unsigned declaration submitted June 4, 2004) cannot be used to support the proposed changes.

Where a \*foreign priority document under 35 U.S.C.119 is of record in the >U.S.<application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending >U.S.<application.*Ex parte Bondiou*, 132 USPQ 356 (Bd.App.1961). This prohibition applies regardless

of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. This prohibition does not apply \*\*where the \*>U.S.<application explicitly incorporates \*\*>the foreign priority<document by reference.

- II. Clearly state that the new substitute specification contains no new matter.

### ***Specification***

The amendment filed September 25, 2003 was objected to under 35 U.S.C. 132 because it appeared to introduce new matter into the disclosure by adding the composition of materials classified under ISP 5832/7 standard. This objection has been overcome by applicants' submission of a copy of ISO International Standard for the ISO 5832/7.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4 to 14, 16 to 18, 20 to 24 and 26 to 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

I. In claims 4 to 9, 17, 18 and 20 to 22 the new claim language, "and titanium and beryllium for the balance" does not find support in the original English language version of the application.

II. In claims 10 to 14, 16, 23, 24 and 26 to 28 the new claim language, "and iron for the balance" does not find support in the original English language version of the application.

Each of these new matter issues can be overcome by the submission of a substitute specification in accordance with the Examiner's guidance as set forth above.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 to 9, 17, 18 and 20 to 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claims 4 to 9, 17, 18 and 20 to 22 the meaning of the claim language, "and titanium and beryllium for the balance" does not find support in the original English language version of the application. Does this language mean that titanium and beryllium are the balance or that beryllium alone is the balance?

Regarding the 112 rejections set forth above, those skilled in the art would not understand what is claimed even when the claims are read in light of the specification.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 to 14, 16, 23, and 26 to 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fariabi (U.S. Patent No. 5,636,641).

Fariabi teaches a cobalt-nickel-chromium alloy having a composition that overlaps the alloy composition recited in the instant claims (column 2, lines 22 to 38). Fariabi teaches that the disclosed alloy is used to make elongated intra vascular bodies such as a guidewire, a stent or the like (column 2, lines 9 to 11) as recited in the instant claims.

Fariabi and the claims differ in that Fariabi does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy proportions taught by Fariabi overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve

upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

### ***Response to Arguments***

7. Applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

Applicants' argue that Fariabi teaches up to 3% manganese and up to 20% tungsten and that in contrast the claimed invention does not incorporate either up to 3% manganese or up to 20% tungsten. The Examiner is not persuaded. The phrase, "up to" reads on zero, In re Mochel, 176 USPQ 194 (CCPA 1972). In view of this, manganese and tungsten are optional elements in the alloy disclosed by Fariabi. Further, in view of the use of the transitional term "comprising" (claim 10, line 1) applicants' claims do not preclude the presence of additional alloying elements.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981);



*Ex parte Davis*, 80 USPQ 448,450 (Bd.App.1948)  
("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

See MPEP 2111.03.

### ***Allowable Subject Matter***

8. Claims 4 to 9, 17, 18, 20 to 22 and 24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571)

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272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps